

REMARKS

Claims 21-40 are pending in the present application. In the above amendments, no claims have been amended, no claims have been cancelled, and no new claims have been added. Applicants believe that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a) – Dutta in view of Rao, Wiberg

Claims 21-24, 26-29, 31-34, and 36-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,407,986 to Dutta (hereinafter “Dutta”) in view of U.S. Patent No. 6,272,334 to Rao (hereinafter “Rao”) and in further view of U.S. Patent No. 6,628,946 to Wiberg et al. (hereinafter “Wiberg”). Applicants respectfully traverse this rejection, as detailed below.

MPEP 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, the recently published “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*”, (hereinafter “KSR Guidelines”) further supports the basic requirement for a finding of obviousness as clearly articulated in the following:

To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Office personnel must then articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;

(2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;

(3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and

(4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

The 35 U.S.C. § 103(a) obviousness rejections of claims 21-24, 26-29, 31-34, and 36-39 are improper because the elements for a *prima facie* case of obviousness are not met.

i) The References do not Teach or Suggest All the Features of the Claimed Invention

The rejection fails to meet the criterion that the prior art must teach or suggest all the claims’ limitations or as stated in the KSR Guidelines “a finding that the prior art included each element claimed.” Applicants’ independent claim 21 recites, in part, features such as “*deliver[ing] the information to the mobile station on a forward common channel to be received by all mobile stations monitoring said forward common channel for a push-to-talk*

communication.” Applicants respectfully assert that Dutta, Rao, and Wiberg, either alone or in combination, fail to teach or suggest at least this feature of independent claim 21.

The Examiner relies on Dutta as teaching an apparatus and method for delivering information to a mobile station 110 in a group communication network, including a processor SPP that encapsulates the information inside a frame and forwards the frame to a server 140 for delivery to the mobile on a forward common channel. (See Office Action, pgs. 2-3). Initially, Applicants note that “mobile station 110” referenced by the Examiner is not actually a mobile station, but a “fixed user station 110.” (See, e.g., col. 8, lines 33-34, as cited by the Examiner). Furthermore, FIG. 1 clearly shows that each user station 110, 111, 112, has its own dedicated “fixed link” 135, 136, 137, respectively, for communication with server 140. (See, e.g., col. 6, lines 14-31). Thus, there is no forward common channel between server 140 and the user stations 110, 111, 112, as alleged. It also does not make sense to say that processor SPP encapsulates information in a frame and forwards the frame to server 140 as processor SPP is part of server 140. Moreover, as can be seen in FIG. 1, all frames formatted by processor SPP (using frame formatter 184) are transmitted to satellite dish antennas 150, 156, away from user stations 110, 111, 112. Accordingly, Applicants submit that the current rejection is deficient as Dutta fails to teach or suggest the features of claim 21 alleged by the Examiner.

With regard to Wiberg, the Examiner acknowledges that Dutta and Rao fail to disclose that the information is received by all mobile stations monitoring the forward common channel, but alleges that Wiberg teaches this feature. Applicants note that the Examiner has taken this feature of claim 21 out of context. Claim 21 explicitly recites “deliver[ing] the information to the mobile station on a forward common channel to be received by all mobile stations monitoring said forward common channel for a push-to-talk communication.”

Wiberg has nothing to do with push-to-talk communications. Wiberg is directed to monitoring tags associated with system control parameters for facilitating mobile operation in a particular cell (e.g., cell identity, physical cell parameters, cell traffic load, etc.). The tags are broadcast on a master control channel, and the parameters themselves are broadcast on separate control channels (e.g., slave control channels). Wiberg teaches that a particular mobile (e.g., MS 30) can monitor the master control channel for the tag values to determine whether it is necessary to retrieve the full system control parameters from the other control channels, or whether the mobile already has the needed parameters stored. The portion of Wiberg specifically pointed to by the Examiner (i.e., col. 8, lines 11-34) discusses retaining tag values from an old cell when switching over to a new cell (e.g., during handoff), again to avoid downloading potentially redundant information, thereby conserving power.

In contrast, as stated in the preamble, ‘the information’ delivered according to claim 21 is push-to-talk information. The information delivered via the master control channel of Wiberg is a set of tag values associated with system parameters facilitating mobile operation in a particular cell, not push-to-talk information as in the claimed invention. Accordingly, Wiberg teaches mobile station MS 30 monitoring the master control channel for the tag values. MS 30 is not involved in any sort of group communication, and is certainly not monitoring the master control channel for a push-to-talk communication as in the claimed invention.

Thus, the master control channel of Wiberg does not broadcast push-to-talk information, and MS 30 disclosed in Wiberg does not monitor the master control channel for a push-to-talk communication. Even if combined with the teachings of Dutta and Rao, which Applicants believe is improper as discussed below, Wiberg simply teaches efficient gathering of system parameter information related to mobile operation in a particular cell. A reference merely

showing an arbitrary control channel capable of broadcasting arbitrary control information is not sufficient to read on the above quoted feature of claim 21.

Thus, Wiberg fails to teach or suggest “deliver[ing] the information to the mobile station on a forward common channel to be received by all mobile stations monitoring said forward common channel for a push-to-talk communication,” as recited in independent claim 21. Independent claim 26, 31, and 36 recite similar features. The rejection therefore fails to meet the criterion that the prior art must teach or suggest all the claims’ limitations or as stated in the KSR Guidelines “a finding that the prior art included each element claimed.”

ii) There is not Sufficient Suggestion or Motivation to Combine or Modify the References

Furthermore, the rejection fails to meet the *prima facie* obviousness criterion that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references.

As demonstrated above, the master control channel of Wiberg does not broadcast push-to-talk information, and MS 30 disclosed in Wiberg does not monitor the master control channel for a push-to-talk communication. Moreover, the Examiner has provided no showing that the master control channel is in fact capable of broadcasting push-to-talk information, or what modifications would be required to do so. As used in Wiberg, the master control channel is provided exclusively for broadcasting tag values associated with system parameters of a given cell to mobile stations for the purpose of reducing redundant downloads of those system parameters. Even if the proposed modification were tenable, it would alter the principle of operation in Wiberg by having the master control channel of Wiberg instead broadcast push-to-talk information, and MS 30 monitor the master control channel for a push-to-talk

communication, rather than for tag values of system control parameters, such as cell identity, physical cell parameters, cell traffic load, etc. It is a well known tenet of U.S. patent law that if the proposed modification of a reference would change the principle of operation of the reference's invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP § 2143.01. See also the KSR Guidelines, referenced above, requiring that “each element merely would have performed the same function as it did separately.”

Accordingly, Dutta in view of Rao and Wiberg cannot render obvious, under 35 U.S.C. §103(a), Applicants' invention as presently claimed in independent claims 21, 26, 31, and 36. The nonobviousness of independent claims 21, 26, 31, and 36 also precludes the rejections of claims 22-24, 27-29, 32-34, and 37-39, which depend variously therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. See In re Fine, 5 USPQ.2d 1596, 1600 (Fed. Cir. 1988). See also MPEP § 2143.03.

Therefore, the Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 21-24, 26-29, 31-34, and 36-39.

Claim Rejections under 35 U.S.C. § 103(a) – – Dutta in view of Rao, Wiberg, Sayeedi

Claims 25, 30, 35, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dutta in view of Rao and Wiberg, and in further view of U.S. Patent Publication No. 2002/0145990 to Sayeedi (hereinafter “Sayeedi”). Applicants respectfully traverse this rejection, as detailed below.

Sayeedi fails to cure the deficiencies of Dutta, Rao and Wiberg discussed above with regard to independent claims 21, 26, 31, and 36. Thus, Applicants submit that independent

claims 21, 26, 31, and 36 are patentable over Dutta in view of Rao, Wiberg and Sayeedi. Accordingly, the patentability of independent claims 21, 26, 31, and 36 precludes a rejection of claims 25, 30, 35, and 40 depending variously therefrom, because a dependent claim may not be rejected as obvious if the independent claim from which it depends is nonobvious. See In re Fine, 5, USPQ.2d 1596, 1600 (Fed Cir. 1988), *see also* MPEP § 2143.03.

In addition, Applicants disagree with the Examiner's application of Sayeedi. In the cited section (claim 2 of Sayeedi), Sayeedi teaches a method of performing a packet data call setup including facilitating a point-to-point protocol (PPP) connection between a mobile station and a packet data serving node (PDSN). Again, as with Wiberg, Sayeedi is not related to group communications or push-to-talk communications, but simply shows a packet data call setup between a single mobile and a PDSN. Further, the facilitating includes "sending at least one message received in a short data burst format from the packet control function to the mobile station in at least one short data burst over a common channel." Sayeedi therefore merely teaches forwarding a received short data burst message to the mobile, but in the claimed invention the server first extracts information from a frame and then delivers the information in short data burst form. The proposed modification of the teachings of Sayeedi is in direct conflict with the KSR Guidelines, referenced above, requiring that "each element merely would have performed the same function as it did separately." Accordingly, Applicants submit that Sayeedi is not properly combinable as alleged.

Therefore, Applicants respectfully request that this rejection of dependent claims 25, 30, 35, and 40 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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